

ESTTA Tracking number: **ESTTA112490**

Filing date: **12/01/2006**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following parties oppose registration of the indicated application.

Opposers Information

Name	Starbucks U.S. Brands, LLC
Granted to Date of previous extension	12/03/2006
Address	2525 Starbucks Way Minden, NV 89423 UNITED STATES

Name	Starbucks Corporation d/b/a Starbucks Coffee Company
Granted to Date of previous extension	12/03/2006
Address	2401 Utah Avenue South Seattle, WA 98134 UNITED STATES

Attorney information	Julia Anne Matheson Finnegan, Henderson, Farabow, Garrett and Dunner, LLP 901 New York Avenue, N.W. District of Columbia, DC 20001-4413 UNITED STATES docketing@finnegan.com, andrew.pittman@finnegan.com Phone:202-408-4000
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Applicant Information

Application No	78728596	Publication date	06/06/2006
Opposition Filing Date	12/01/2006	Opposition Period Ends	12/03/2006
Applicant	Burgess, Robert K. P.O. Box 494 Rancho Santa Fe, CA 82067 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. All goods and sevicees in the class are opposed, namely: Retail discount store services in the field of general consumer merchanside, consumer electronics, housewares, cosmetics, jewelry, stationery, bags, games and playthings, eyewear, gifts, candy, sundries, and apparel
Class 043. All goods and sevicees in the class are opposed, namely: Cafe-restaurants; Coffee-house and snack-bar services; Restaurant and bar services; Take-out restaurant services

Attachments	0002643.PDF (10 pages)(601513 bytes)
Signature	/Julia Anne Matheson/
Name	Julia Anne Matheson
Date	12/01/2006

Serial No. 78/728,596. That application was filed on October 7, 2005 under Section 1(b) claiming an intent to use the mark THE BUCK STARS HERE for “café-restaurants; coffee-house and snack-bar services; restaurant and bar services; take-out restaurant services” in Class 43 and “retail discount store services in the field of general consumer merchandise, consumer electronics, housewares, cosmetics, jewelry, stationery, bags, games and playthings, eyewear, gifts, candy, sundries, and apparel” in Class 35.

2. For over a quarter century, Opposers have been in the business of offering cafe, restaurant, and coffee-house services, and retail store services store services featuring coffee, tea, and coffee- and tea-based beverages. Over the years, Opposers have been producing, marketing, distributing, and selling an ever-expanding range of products and services including, among other things, coffee, candy and confectionery products, bakery products, mugs and glassware, coffee-related accessories and equipment, toys, print materials such as newsletters and magazines, music recordings, apparel, gift items, and stored value cards, all under the STARBUCKS mark.

3. Sales of STARBUCKS products and services have been immense, amounting to \$6.4 billion dollars of revenues for 2005 alone. By the conclusion of 2005, Opposers operated at more than 10,500 locations worldwide.

4. Opposers, by and through their related companies, have used the STARBUCKS trade name in commerce since at least as early as 1971.

5. Opposer Starbucks U.S. Brands, LLC is the owner of, among others, the following United States trademark registrations for the mark STARBUCKS and STARBUCKS-formative marks:

Mark	Reg. No./Reg. Date	Goods
STARBUCKS & Design	1,417,602 November 18, 1986	Coffee, tea, spices, herb tea, chocolate and cocoa in Class 30; coffee bar services and coffee distribution services and retail store services in Class 42
STARBUCKS COFFEE & Design	1,542,775 June 6, 1989	Coffee in Class 30; restaurant services featuring coffee and espresso beverages and also serving sandwiches and breakfasts in Class 42
STARBUCKS COFFEE & Design	1,815,937 January 11, 1994	Hand operated coffee grinders and coffee mills, non electric coffee makers, insulated cups, reusable non paper coffee filters, beverage stowaways (cup holders for use on car and boat dashboards), non paper coasters, thermal insulated bottles, and housewares; namely, coffee cups, non electric coffee pots not of precious metal, cups, mugs, dishes, trivets, and canisters in Class 21; Ground and whole bean coffee, cocoa, tea, powdered chocolate and powdered vanilla, muffins, pastries, cookies, breads, granola, and candy; namely, chocolates, chocolate covered coffee beans, chocolate covered cherries, and chocolate covered almonds in Class 30; Retail store services featuring of all of the above goods as well as decorative magnets, paper coffee filters, and electric appliances; namely, power operated coffee grinders, espresso makers, coffee makers, percolators, and coffee pots; distributorship services of all the foregoing goods; restaurant and cafe services in Class 42
STARBUCKS COFFEE & Design	1,815,938 January 11, 1994	Hand operated coffee grinders and coffee mills, non electric coffee makers, insulated cups, reusable non paper coffee filters, beverage stowaways (cup holders for use on car and boat dashboards), non paper coasters, thermal insulated bottles, and housewares; namely, coffee cups, non electric coffee pots not of precious metal, cups, mugs, dishes, trivets, and canisters in Class 21; Ground and whole bean coffee, cocoa, tea, powdered chocolate and powdered vanilla, muffins, pastries, cookies, breads, granola, and candy; namely, chocolates, chocolate covered coffee beans, chocolate covered cherries, and chocolate covered almonds in Class 30; Retail store services featuring the above goods as well as decorative magnets, paper coffee filters, and

Mark	Reg. No./Reg. Date	Goods
		electric appliances; namely, power operated coffee grinders, espresso makers, coffee makers, percolators, and coffee pots; distributorship services of all the foregoing goods; restaurant and cafe services in Class 42
STARBUCKS COFFEE (stylized)	2,227,835 March 2, 1999	Ground and whole bean coffee; tea; cocoa; coffee and espresso beverages and beverages made with a base of coffee, espresso, and/or milk; powdered flavorings; flavoring syrups; baked goods, including muffins, scones, biscuits, cookies, packaged foods; sandwiches and prepared foods; chocolate and confectionery items; dried fruits, juices; soft drinks; electric appliances, namely, kettles, coffee makers, espresso makers and coffee grinders; housewares, insulated coffee and beverage cups, non-paper coasters, insulated vacuum bottles, coffee cups, tea cups and mugs, glassware, dishes, plates and bowls, trivets, storage canisters, non-electric drip coffee makers and non-electric plunger-style coffee makers; paper and non-paper coffee filters; furniture; watches; clocks; toys; books; musical recordings; all of the foregoing services in Class 35

Mark	Reg. No./Reg. Date	Goods
STARBUCKS COFFEE (stylized)	2,227,837 March 2, 1999	Wholesale distributorships, retail outlets and mail order services featuring ground and whole bean coffee; tea; cocoa; coffee and espresso beverages and beverages made with a base of coffee, espresso, and/or milk; powdered milk; powdered flavorings; flavoring syrups; baked goods, including muffins, scones, biscuits, cookies, pastries, cakes and breads, and ready-to-make mixes of the same; packaged foods; sandwiches and prepared foods; chocolate and confectionery items; ready-to-eat cereals; dried fruits, spreads; juices; soft drinks; electric appliances, namely, kettles, coffee makers, espresso makers and coffee grinders; housewares, non-electric appliances and related items, namely, hand-operated coffee grinders and coffee mills, insulated coffee and beverage cups, collapsible cup carriers and candies, non-paper coasters, insulated vacuum bottles, coffee cups, tea cups, mugs, glassware, dishes, plates and bowls, trivets, storage canisters, non-electric drip coffee makers and non-electric plunger-style coffee makers; paper and non-paper coffee filters; furniture; watches; clocks; toys; books; musical recordings; T-shirts; caps; sweatshirts; jackets; aprons, and other clothing items; all of the foregoing services in Class 35
STARBUCKS COFFEE & Design	2,325,182 March 7, 2000	Wholesale distributorships, retail outlets and mail order services featuring ground and whole bean coffee; tea; cocoa; coffee and espresso beverages and beverages made with a base of coffee, espresso, and/or milk; powdered milk; powdered flavorings; flavoring syrups; baked goods, including muffins, scones, biscuits, cookies, pastries, cakes and breads, and ready-to-make mixes of the same; packaged foods; sandwiches and prepared foods; chocolate and confectionery items; ready-to-eat cereals; dried fruits, spreads; juices; soft drinks; electric appliances, namely, kettles, coffee makers, espresso makers and coffee grinders; housewares, non-electric appliances and related items, namely, hand-operated coffee grinders and coffee mills, insulated coffee and beverage cups, collapsible cup carriers and candies, non-paper coasters, insulated vacuum

Mark	Reg. No./Reg. Date	Goods
		bottles, coffee cups, tea cups, mugs, glassware, dishes, plates and bowls, trivets, storage canisters, non-electric drip coffee makers and non-electric plunger-style coffee makers; paper and non-paper coffee filters; furniture; watches; clocks; toys; books; musical recordings; T-shirts; caps; sweatshirts; jackets; aprons, and other clothing items in Class 35
STARBUCKS	2,073,104 June 24, 1997	Wholesale supply, retail outlets and mail order services featuring ground and whole bean coffee, tea, cocoa, coffee and espresso beverages and beverages made with a base of coffee, espresso, and/or milk, powdered flavorings, flavoring syrups, baked goods, including muffins, scones, biscuits, cookies, pastries, cakes and breads, and ready-to-make mixes of the same, packaged foods, sandwiches and prepared foods, chocolate and confectionery items, granola, dried fruits, spreads, juices, soft drinks, electric appliances, namely, kettles, coffee makers, espresso makers and coffee grinders, housewares, non-electric appliances and related items, namely, hand operated coffee grinders and coffee mills, insulated coffee and beverage cups (made of plastics and/or ceramics), collapsible cup carriers and caddies, non-paper coasters, insulated vacuum bottles, coffee cups, tea cups and mugs, glassware, dishes, plates and bowls, trivets, storage canisters, non-electric drip coffee makers and non-electric plunger-style coffee makers, paper and non paper coffee filters, furniture, clocks, toys, books, musical recordings, T-shirts, caps, sweatshirts, jackets, aprons and other clothing items, and for restaurant, cafe and coffee house services in Class 42
STARBUCKS	1,444,549 June 23, 1987	Retail store services and distributorship services for coffee, tea, and spices, coffee café services in Class 42
STARBUCKS COFFEE and Design	2,039,849 February 25, 1997	Wholesale supply, retail outlets and mail order services featuring ground and whole bean coffee; tea; cocoa; coffee and espresso beverages and beverages made with a base of coffee, espresso, and/or milk; powdered flavorings; flavoring syrups; baked goods, including muffins, scones, biscuits, cookies,

Mark	Reg. No./Reg. Date	Goods
		<p>pastries, cakes and breads, and ready-to-make mixes of the same; packaged foods; sandwiches and prepared foods; chocolate and confectionery items; granola; dried fruits; spreads; juices; soft drinks; electric appliances, namely, kettles, coffee makers, espresso makers and coffee grinders; housewares, non-electric appliances and related items, namely, hand operated coffee grinders and coffee mills, insulated coffee and beverage cups (made of plastics and/or ceramics), collapsible cup carriers and caddies, non-paper coasters, insulated vacuum bottles, coffee cups, tea cups and mugs, glassware, dishes, plates and bowls, trivets, storage canisters, non-electric drip coffee makers and non-electric plunger-style coffee makers; paper and non paper coffee filters; furniture; clocks; toys; books; musical recordings; T-shirts, caps, sweatshirts, jackets, aprons and other clothing items; and for restaurant, cafe and coffee house services in Class 42</p>
STARBUCKS COFFEE (Stylized Block)	2,184,259 August 25, 1998	Restaurant, cafe and coffee house services in Class 42
STARBUCKS COFFEE (Stylized)	2,035,005 February 4, 1997	<p>Wholesale supply, retail outlets and mail order services featuring ground and whole bean coffee; tea; cocoa; coffee and espresso beverages and beverages made with a base of coffee, espresso, and/or milk; powdered flavorings; flavoring syrups; baked goods, including muffins, scones, biscuits, cookies, pastries, cakes and breads, and ready-to-make mixes of the same; packaged foods; sandwiches and prepared foods; chocolate and confectionery items; granola; dried fruits; spreads; juices; soft drinks; electric appliances, namely, kettles, coffee makers, espresso makers and coffee grinders; housewares, non-electric appliances and related items, namely, hand operated coffee grinders and coffee mills, insulated coffee and beverage cups (made of plastics and/or ceramics), collapsible cup carriers and caddies, non-paper coasters, insulated vacuum bottles, coffee cups, tea cups and mugs, glassware, dishes, plates and bowls, trivets, storage canisters, non-electric</p>

Mark	Reg. No./Reg. Date	Goods
		drip coffee makers and non-electric plunger-style coffee makers; paper and non paper coffee filters; furniture; clocks; toys; books; musical recordings; T-shirts, caps, sweatshirts, jackets, aprons and other clothing items; and for restaurant, cafe and coffee house services in Class 42
STARBUCKS COFFEE and Design	2,266,352 August 3, 1999	Restaurant, cafe and coffee house services in Class 42

6. The foregoing registrations are valid and subsisting and constitute *prima facie* evidence of the validity of the marks and registrations, of Opposers' ownership of and exclusive right to use the marks in commerce, and provide constructive notice of ownership thereof by Opposers.

7. Opposers have continuously used the STARBUCKS marks and trade name in commerce since long prior to Applicant's October 7, 2005 filing date. Opposers' pleaded Registrations were also filed and issued well prior to the October 7, 2005 filing date of Application Serial No. 78/728,596.

8. As a result of Opposers' extensive sales, promotion, advertising, and commercial success, Opposers' STARBUCKS marks have achieved such widespread public recognition that these marks have become among the best known and most famous trademarks in the United States.

9. Opposers' STARBUCKS marks became famous well prior to the October 7, 2005 filing date of Application Serial No. 78/728,596.

COUNT I: LIKELIHOOD OF CONFUSION

10. Opposers repeat and reallege each and every allegation set forth in paragraphs 1 through 9.

11. Applicant's THE BUCK STARS HERE mark is comprised of a transposition of the formative terms STAR(S) and BUCK(S) and covers services that are identical and/or similar to those of Opposer.

12. Applicant's THE BUCK STARS HERE mark so resembles Opposers' STARBUCKS marks and trade name as to be likely, when applied to the services covered by Application 78/728,596 to cause confusion, to cause mistake, or to deceive.

COUNT II: DILUTION

13. Opposers repeat and reallege each and every allegation set forth in paragraphs 1 through 12.

13. In view of the similarities of the parties' marks and the fame of Opposers' STARBUCKS marks, Applicant's mark THE BUCK STARS HERE so closely resembles Opposers' famous marks and trade name STARBUCKS that it is likely to dilute and will dilute the distinctive quality of Opposers' STARBUCKS Marks and trade name.

WHEREFORE, Opposers believe that they are being, and will be damaged by the registration of the mark shown in Application Serial No. 78/728,596 and request that the opposition be sustained, and that registration to Applicant be refused.

Any deficiency in the fee should be charged to our Deposit Account No. 06-0916.

Respectfully Submitted,

Dated: December 1, 2006

By: 

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